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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/360,184	12/20/1994	DONALD B. APPLEBY	4233C3	9348

27752 7590 07/12/2004

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EXAMINER	
WHITE, EVERETT NMN	

ART UNIT	PAPER NUMBER
1623	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/360,184	APPLEBY ET AL.	
	Examiner	Art Unit	
	EVERETT WHITE	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 April 1999* .

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5,8,9,13-15,23,27,28,30,43-45,48,51,54,55 and 62-118* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *63-118* is/are allowed.

6)☒ Claim(s) *1,5,8,9,13-15,23,27,28,30,43-45,48,51,54,55 and 62* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. The amendment filed March 9, 2004 has been received, entered and carefully considered. The amendment affects the instant application accordingly:

(A) Claims 2-4, 7, 10-12, 16-22, 24-26, 29, 31-42, 46, 47, 49, 50, 52, 53 and 56-61 have been previously canceled;
(B) Claims 63-118 have been previously requested to be subjected to an Interference under C.F.R. §1.607;
(C) Comments regarding Office Action have been provided drawn to:
(i) 103(a) rejection, which has been maintained for the reasons of record.

2. Claims 1, 5, 8, 9, 13-15, 23, 27, 28, 30, 43-45, 48, 51, 54, 55 and 62-118 are pending in the case.

3. The text of those sections of Title 35, U. S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

4. Claims 1, 5, 6, 8, 9, 13-15, 23, 27, 28, 30, 43-45, 48, 51, 54, 55 and 62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Willemse (US Patent No. 4,973,682) or Volpenhein (US Patent No. 4,517,360) in view of Balint et al (US Patent No. 3,689,461), Balint et al (US Patent No. 3,679,368), Setzler (US Patent No. 3,567,369) or Mansour (US Patent Nos. 4,449,828) for the reasons set forth on pages 3-7 in the Office Action filed November 5, 2003.

5. Applicant's arguments filed March 9, 2004 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that the Willemse '682 patent does not teach or suggest a continuous process carried out under conditions of backmixing, and specifically, under conditions of backmixing suitable for maintaining within a reaction mixture a level of partial fatty acid esters of polyol that is sufficient to emulsify the reaction mixture as recited in Claims 1 and 62. Applicants further argue against the rejection of the claims on the ground that the Volpenhein patent does not teach or suggest a continuous process, particularly wherein an initial stage of the reaction is carried out in a continuous manner under conditions of back-

mixing or, more specifically, under conditions of backmixing suitable for maintaining within the reaction mixture a level of lower partial fatty acid esters of the polyol that is sufficient to emulsify the reaction mixture as required by claims 1 and 62. Similarly, Applicants also argue that they find no teaching or suggestion by the Volpenhein patent wherein at least a final stage of the interesterifying reaction is carried out in a continuous manner under conditions approaching plug-flow conditions after the degree of esterification of the polyol has reached at least about 50%, as further required by claim 62. These arguments are not persuasive because the instant rejection of the claims is base on a combination of references wherein other references include the conditions related to backmixing. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is noted that on page 21, last paragraph that the instant specification discloses that "the final stage or stages, of the reaction should be carried out under plug-flow, or batch, conditions to prevent backmixing and thereby achieve high degrees of esterification". In column 2, 4th paragraph, the Willemse '682 patent discloses a degree of conversion of the final stage of the reaction of at least 70%, which clearly suggests carrying out the reaction in the final stage under plug-flow conditions. Also see the diagrammatical drawing of the apparatus used in Figure 1 of the Balint 461 patent (one of the secondary references used to reject the claims), which suggests a process whereby the reaction is carried out under plug flow conditions by feeding the output of the initial stage into a series of at least two continuous stirred tank reactors. Example two of the Balint '461 patent refers to Figure 1, wherein a process is described that involves part of the partially esterified material which is produced being returned to the inlet of the circulating pump to be combined with fresh paste, which appears to be within the scope of the backmixing step claimed in the instant application.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Willemse and Volpenhein's process for preparing polyol fatty acid polyesters by applying the various conditions under which the process is to be carried out as suggested by the Balint '461, Balint et al '368, Setzler and Mansour patents, all of which teach carrying out a process in a continuous operation and under conditions of backmixing and plug flow, since such process steps for preparing polyol polyester and such conditions for the operation of a continuous process increases the quality and quantity of the desired product..

With regard to applicants argument against the Willemse '059 EP patent, applicants argue that in view of the showing under 37 C.F.R §1.608(b) in support of the Request for Interference Under 37 C.F.R. §1.607 filed April 19, 1999, the present invention was reduced to practice at least as early as January 20, 1989 and was not abandoned, suppressed or concealed between the reduction to practice in January 1989 and the filing of the original parent application on September 11, 1990. Applicants argue that in contrast, the effective date of the Willemse '059 EP patent is its publication date of January 3, 1990, subsequent to the reduction to practice of the present invention. Applicants conclude that the Willemse '059 EP patent is not proper prior art with respect to the present application. The Willemse '059 EP patent has been dropped as a reference against the instant claims in view of this argument.

Accordingly, the rejection of Claims 1, 5, 6, 8, 9, 13-15, 23, 27, 28, 30, 43-45, 48, 51, 54, 55 and 62 under 35 U.S.C. § 103(a) as being unpatentable over Willemse (US Patent No. 4,973,682) or Volpenhein (US Patent No. 4,517,360) in view of Balint et al (US Patent No. 3,689,461), Balint et al (US Patent No. 3,679,368), Setzler (US Patent No. 3,567,369) or Mansour (US Patent Nos. 4,449,828) is maintained for the reasons of record.

Summary

6. Claims 1, 5, 8, 9, 13-15, 23, 27, 28, 30, 43-45, 48, 51, 54, 55 and 62 are rejected; Claims 63-118 have been requested to be subjected to an Interference under C.F.R. §1.607.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner's Telephone Number, Fax Number, and Other Information

8. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit out website at **www.uspto.gov** and click on the button "Patent Electronic Business Center" for more information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (571) 272-0660. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reach on (571) 272-0661. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

E.White

James O. Wilson
Supervisory Primary Examiner
Technology Center 1600